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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,116	05/13/2005	Thomas Breitbach	2345/208	3278
26646 7590 08/31/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
SMITHERS, MATTHEW				
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2437				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,116

Applicant(s)

BREITBACH, THOMAS

Examiner

Matthew B. Smithers

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed March 30, 2009, specifically the arguments concerning the Declaration/Oath, have been fully considered but they are not persuasive. Applicant argues the no amendment was "specifically referred to" in the oath or declaration and therefore the omission does not affect the Declaration as signed. Applicant is correct that the present signed declaration does clearly declare applicant's review and understanding of the contents of the application including the claims as filed on May 13, 2005. However the declaration of May 13, 2005 does not declare applicant's review and understanding of the contents of the amendment filed March 30, 2009 or any other amendment filed in the application. Therefore, applicant needs to either submit a declaration that includes the language of 37 CFR 1.63(b)(2) or applicant needs to submit a declaration each time an amendment is filed.

Applicant's arguments, see remarks, filed March 30, 2009, with respect to the rejection(s) of claim(s) 11-20 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US patent 6,516,192 granted to Spaur et al and US patent application 20030061166 granted to Saito et al.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,516,192 granted to Spaur et al.

Regarding claim 18, Spaur meets the claimed limitations as follows:

"A device for making available security functions for the transmission of data from and to a subscriber terminal unit of a mobile communications network, including a security and filtering device comprising:

a filter component for the real-time analysis of the data flow from and to the subscriber terminal unit;

an authentication component for authenticating the subscriber vis-a-vis the security and filtering device;

an administrative component as the interface to the subscriber; and

a database for storing subscriber-specific and network operator-specific data and security and filtering functions." see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B.

Regarding claim 19, Spaur meets the claimed limitations as follows:

"The device of claim 18, wherein the security and filtering component is positioned in one or more network nodes of the mobile communications network." see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B.

Regarding claim 20, Spaur meets the claimed limitations as follows:

"The device of claim 19, wherein special filter components are established for certain data contents." see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15, 17, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,516,192 and further in view of US patent application 20030061166 granted to Saito et al.

Regarding claim 11, Spaur teaches a real-time analysis of data flow from and to a device in a mobile communications network, where the data has contents specified by a subscriber (see column 5, lines 33-65). Spaur further teaches making security functions available for the transmission of the data (see column 5, line 66 to column 6, line 51; column 7, lines 43-62; column 11, lines 47-60) and where the transfer of the

data is limited to a predefined measure such as the arising data transfer volume or the arising data transfer cost (see column 8, lines 6-63 and column 10, line 41 to column 11, line 50 and figures 1-5B). Spaur fails to specifically teach the subscriber is authenticated via the device before the security functions are made available for transmitting the data. Saito teaches a method where security settings of a portable terminal for transmitting and receiving data are determined after the user (subscriber) is authenticated (see paragraphs [0044]-[0069]). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Saito's security management system with Spaur's communications system in order to prevent an unauthorized subscriber or network operator from modifying the operating parameters of the transfer of data in the mobile communications network. One of ordinary skill would have been motivated to incorporate the step of authenticating the subscriber or network operator because this ensures only legitimate subscribers or network operators can access and control the operating parameters in the transfer of data.

Regarding claim 12, Spaur as modified above (see claim 11) teaches recognizing and processing further data traffic from and to specified senders and receivers (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 13, Spaur as modified above (see claim 11) teaches the recognized data is at least one of selected, isolated, deleted and made available to one of the subscriber and the network operator for further processing (see column 5, line 33

to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 14, Spaur as modified above (see claim 11) teaches filtering of a IP/TCP- based data traffic is carried out (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 15, Spaur as modified above (see claim 11) teaches the predefined measure is established by one of the subscriber and the network operator (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 17, Spaur as modified above (see claim 11) teaches notifying at least one of the subscriber and network operator upon the recognition of at least one of certain data content and sender (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 22, Spaur as modified above (see claim 11) teaches storing temporarily the data such that the stored data is retrievable by the subscriber (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 23, Spaur as modified above (see claim 11) teaches filtering data traffic such that data packets in the data traffic of at least one of a certain IP address and a certain service port are refused transmission (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Regarding claim 24, Spaur as modified above (see claim 11) teaches the contents of the data are analyzed and searched according to a predefined pattern (see column 5, line 33 to column 6, line 51; column 7, lines 43-62 and column 11, lines 47-60 and figures 1-5B).

Allowable Subject Matter

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 21, the cited prior art does not specifically teach the authentication method is adjustable at least one of dynamically and interactively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew B Smithers/
Primary Examiner, Art Unit 2437